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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,284	06/12/2000	FRANCOIS SMOLAREK	106498	5209
25944	7590	10/05/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER HECKENBERG JR, DONALD H	
			ART UNIT 1722	PAPER NUMBER
DATE MAILED: 10/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/592,284	Applicant(s) SMOLAREK, FRANCOIS	
	Examiner Donald Heckenberg	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-22,24-33,35-44,46-55,57-76,78-87 and 89-119 is/are pending in the application.
- 4a) Of the above claim(s) 87,89-98,116 and 117 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 80,81 and 101 is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-22,24-33,35-44,46-55,57-76,78,79,82-86,99,100,102-114,118 and 119 is/are rejected.
- 7) ☒ Claim(s) 115 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2004 has been entered.

2. Claims 87, 89-98, 116, and 117 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

3. Claim 65 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 65 recites that an internal surface is configured to be in contact with the product and the side wall is deprived of recesses opening out into the internal surface. These limitations are recited in lines 8 and 9 of claim 55, from which

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claim 65 depends. Claim 65 therefore fails to further limit its parent claim.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-6, 10, 33, 35-38, 43, 44, 46-49, 54, 69, 72, 73, 75, 78, 79, 85, 86, 99, 100, 102, 103, 110, 111, 113, and 114, and 118 are rejected under 35 U.S.C. 102(b) as being anticipated by Henning (U.S. Pat. No. 3,934,810; previously of record).

Henning discloses a flexible mold. In the embodiment shown in figures 7 and 8, the mold comprises a side wall (80) having an external surface (86) and an internal surface configured to be in contact with the product (within cavity 81). The side wall is deprived of recesses opening out into the internal surface of the mold (see fig. 8). The side wall is provided with recesses in the form of notches (87) facilitating the radial deformation of the mold (cl. 1, ll. 59-66). The notches have longitudinal edges having a length on the external surface

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(see fig. 7). A portion (93) of the edge adjacent to a periphery of the mold is spaced apart over at least part of the length prior to any deformation of the mold (see cl. 3, ll. 52-54 noting the recesses portion 93 to be a rounded channel, and fig. 7 showing the channel extending to the external surface of the mold, thereby constituting an edge portion of the recess not touch over a portion of the recess length prior to deformation of the mold).

Henning further discloses the notches to extend substantially over an entire height of the mold all the way to a bottom end of the mold beyond a bottom of the inner cavity (81) of the mold, and the notches being uniformly distributed in the periphery of the mold (see figs. 7-8). As noted above, a bottom of the notch is rounded (cl. 3, ll. 52-54). Henning also discloses the mold to be provided with a flange (77) at the top portion surrounding an opening of the mold (see fig. 7). In an alternative embodiment shown in fig. 9, Henning discloses that the depth of the notches may decrease on coming towards a bottom end of the mold (see cl. 4, ll. 13-29).

Claims 69, 72, 73, and 114 recite that the mold is configured to be filled with a cosmetic product. The actual intended use of the apparatus, whether it be to make a cosmetic product or anything else, is not germane to the issue of

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patentability of the apparatus claims. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. & Pat. App. 1963); MPEP § 2115. In the instant case, Henning teaches the mold to be used with "a hardenable mixture" (col. 1, l. 6), and to comprise a completely closed cavity (81) for containing the mixture (see fig. 7). Therefore, the apparatus of Henning is capable of being used with a hardenable mixture such as that which would form a cosmetic product, and therefore anticipates the limitations of claims 69, 72-73, 86, and 114.

Claim 118 recites that the mold is made of a material that is physically and chemically compatible with polydimethyl siloxane silicon at a temperature of about 100°C. Although Henning does not disclose the use of the apparatus for molding polydimethyl siloxane silicon, this actual use of this material is a limitation is directed towards the intended use of the apparatus, which is not germane to the issue of patentability as discussed above. Henning does disclose that the apparatus is capable of molding hardenable materials. (see for example, col. 1, ll. 3-6). Given the disclosed structure, the mold of Henning

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would inherently have to be made of a material physically and chemically compatible with polydimethyl siloxane silicon.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 7-10, 39-42, 50-53, 82-84, and 104-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning.

Henning discloses the mold as described above. Henning does not disclose the mold to have sixteen to twenty notches, or

more specifically, eighteen notches. However, Henning does teach that the number of notches is not critical, and that more or less can be included (see cl. 4, ll. 30-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold of Henning as such to have provided eighteen notches because the number of notches is not critical and could be adapted to meet a particular use of the apparatus as suggested by Henning.

Claims 7, 39, 50, 84, and 104 recite that the maximum depth of the notches is greater than or equal to 4 mm. Claims 9, 42, 53, and 106 recite that the thickness of the side wall in the recess is greater than or equal to 1 mm. Henning notes that size of the notches and wall must be as such that the integrity of the shaping cavity remains intact (cl. 4, ll. 44-52).

Henning thus discloses that the size of the notches and wall are cause-effective variables that determine the integrity of the mold based for particular molding conditions. The determination of optimum values of cause effective variables are generally seen as within the skill of one practicing the art absent the showing of an unexpected result. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). In the instant case, given Henning disclosure of the relation of mold integrity to the size of the notches and

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wall, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have varied the sizes used for the notches and wall to include such dimensions as 4 mm or greater for the notches and 1 mm or greater for the side wall in the recesses because this would allow for the optimum integrity of the mold based on these cause effective variables.

9. Claims 11, 13-22, 24-32, 55, 57-68, 70, 71, 74, 76, 108, 109, and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning as applied to claims 1, 3-10, 33, 35-44, 46-54, 69, 72, 73, 75, 78, 79, 82-86, 99, 100, 102-107, 110, 111, 113, 114, and 118, and in view of Fox et al. (U.S. Pat. No. 3,937,438; previously of record).

Henning discloses and suggests the apparatus as described above. Henning does not disclose the mold cavity opening to have a sloping bottom wall, or a mold cavity having a part formed by two successive conical surfaces converging towards an opening in the mold, or the mold cavity to be partially defined by a conical surface.

The mold cavity and mold cavity opening shapes determine the shape of the product to be manufactured. Henning teaches different cavity shapes which would form products of different

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shapes (compare cavity 25 in the embodiment shown in figures 2-4, with cavity 81 shown in figures 7-8). In the same field of endeavor, Fox teaches another example of a different cavity shape (21) to produce different shaped products (45).

Therefore, it is known in the art that the shape of the mold cavity and mold cavity opening may be manipulated in order to produce products of different shapes.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the mold cavity and mold cavity opening of Henning as such to have a slopping bottom wall, two successive converging conical surfaces, or be partially defined by a conical surface because these shapes would have allowed for the molding of correspondingly shaped products as is suggested by Henning and Fox.

10. Claim 119 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henning in view of Llorente Hompanera (U.S. Pat. No. 6,197,359; previously of record).

Henning discloses the molding apparatus as describe above. Henning notes that the mold is made of flexible elastomeric materials (cl. 2, ll. 43-47), but does not specify a specific material.

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Llorente Hompanera discloses that fluoro silicone rubber materials are known for making flexible elastomeric molds (cl. 1, ll. 38-46 and ll. 63-64).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have used a fluoro silicone rubber for construction of the mold of Henning because such a material is known for its flexible elastomeric properties as suggested by Llorente Hompanera.

11. Claims 80, 81, and 101 are allowed. See the reasons for indicating allowable subject matter in the previous Office Action.

12. Claim 115 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

 10-1-04
Donald Heckenberg
A.U. 1722